REMARKS

Claims 2-22 are all the claims pending in the application.

Claims 19 and 21 are allowed.

Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2-17, 20, and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over previously-cited Hashizume et al. (US 5,592,258, hereafter "Hashizume") in view of newly-cited Enomoto (US 6,324,345). Applicant respectfully traverses the rejection with the following comments.

Enomoto relates to a method of acquiring additional information for performing image processing by reading a novel bar code from a photographic film.

Regarding independent claims 2 and 20, the Examiner concedes that Hashizume does not disclose a mask opening that is a mask slit extending in a width direction of a photo film, so that the mask slit is longer in the width direction of the photo film than a passing direction of the photo film. The Examiner asserts that Enomoto makes up for this deficiency of Hashizume and further asserts that it would have been obvious to modify Hashizume by Enomoto to include the mask slit disclosed in Enomoto. Specifically, the Examiner asserts that it would have been obvious to make the modification, because it would allow users to define the projected light from the film to have a specified narrow shape in the position corresponding to the reading position.

However, Applicant submits that one of ordinary skill in the art would not have been motivated or had a suggestion to combine the references as suggested by the Examiner. Hashizume discloses a film transporting apparatus, which uses an area sensor. As described in the reference,

> *When the image sensor 51 images the opening 31a of the negative mask 31 along the optical path L1 when the half-size film 2 is located on the negative mask 31, as illustrated in FIG. 20(a), the projection 31b is not observed and the frame 2a comprising the image portion of the film 2 is located within the opening 31a. On the other hand, when the opening 31a of the opening 31 is observed from the view range L2 of the operator, as illustrated in FIG. 20(b), the projection 31a may be observed as being overlapped with the frame 2a of the film 2. Since this projection 31b has the width W corresponding to the length of the shorter side of the half-size film frame as described hereinbefore, by seeing whether the projection 31b is precisely overlapped with the frame 2a of the film 2 or not, it may be confirmed whether the image area, i.e. the frame of the film 2 is stopped at the proper position or not.*
>
> *When the full-size film frame 2[a] is located on the negative mask 31, by observing whether the image area, i.e. the frame 2a of the film 2 is contained within the opening 31a of the negative mask 31 or not, it may be judged whether the frame is stopped at the proper position or not.* Col. 16, lines 24-44.

In other words, Hashizume's apparatus uses the mask opening 31a to determine whether a frame of the film is positioned properly. By contrast, if Hashizume were modified to have the narrow mask slit disclosed by Enomoto, the mask opening could not be used to determine whether the frame is positioned properly. This is the case, because the frame could be significantly offset from the proper position and still have the frame within the mask slit, since only a small portion of the frame is visible through the mask slit. Hence, one of ordinary skill in the art would not have been motivated to combine the references. Therefore, Applicant submits that claims 2 and 20 are allowable over the prior art.

Furthermore, claims 3-17 and 22 are allowable, at least because of their dependence from claim 2.

With further regard to claim 4, Applicant submits that Hashizume does not teach or suggest the limitations of the claim. The Examiner asserts (Office Action, page 11) that image sensor 51 reads line by line, but there is no support for this assertion in the reference. The Examiner's assertion is simply unsupported speculation. Applicant submits that the sensor can be an area sensor in which case line-by-line reading is not a necessary result. The features of claim 4 are not inherent or required in the cited art. Hence, Applicant submits that claim 4 is allowable for this reason also.

Claim 5 recites a protrusion portion disposed on the mask member to extend in a width direction of the photo film, provided with the mask slit formed in a middle thereof, for flexing the photo film in the longitudinal direction to remove flexing in the width direction. Applicant submits that Hashizume does not teach or suggest the claimed protrusion portion. The Examiner contends that the press rollers 89a-89e of FIG. 3 correspond to the claimed protrusion portion, but Applicant disagrees. The press rollers are for transporting the film through the device of the reference. See col. 15, lines 22-25. Thus, the press rollers do not have the same function as the protrusion portion of claim 5, despite the Examiner's assertion to the contrary. Since rollers 89a-89e are used for conveyance, there would be no motivation to introduce flexing into the film in the longitudinal direction. The introduction of flexing would indicate lack of transport of the film which directly contradicts the disclosed function of the rollers 89a-89e in the references. The modification suggested by the Examiner cannot be correct. Furthermore, Hashizume does not disclose the structure of the claimed protrusion portion, and the Examiner has not pointed to

any part of the reference, which allegedly discloses a protrusion portion. Hence, claim 5 is allowable for this reason too.

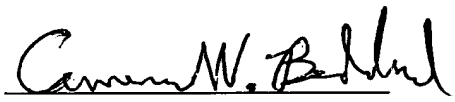
Also, Hashizume fails to disclose the cylindrical ridge claimed in claim 8. Again, the Examiner points to the pressing rollers 89a-89e, but the pressing rollers 89a-89e do not correspond to the protrusion portion. Moreover, Hashizume does not disclose a cylindrical ridge, and the Examiner has not identified such a feature in the reference. Hence, claim 8 is allowable for this reason too.

Regarding claim 10, the Examiner asserts in the "Response to the Arguments" that one of ordinary skill in the art would consider the retaining to be a magnetic attraction for retention of a retainer member. However, the Examiner has provided no support for this assertion. Additionally, there is no teaching or suggestion in the reference of providing retention by magnetic attraction. The Examiner's rebuttal, at best, only suggests that magnetism "could be" used to retain elements of the invention. Such probabalistic statements regarding teachings in the prior art cannot support an anticipation rejection. In re Robertson, 49 U.S.P.Q.2d 1949, 1251 (Fed. Cir 1999). Thus, Applicant submits that the rejection of claim 10 is improper, and claim 10 is allowable for this additional reason.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Cameron W. Beddard
Registration No. 46,545

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: May 13, 2004